

Serial No. 10/517,099

Amend. In Resp. to Off. Act. of Feb. 16, 2006

UTILITY PATENT

B&D No. P-US-PR-1080

Amendments to the Drawings:

The attached sheet of drawings includes changes to Fig. 2. This sheet replaces the original sheet including Fig. 2.

Attachment: Replacement Sheet

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REMARKS

Applicants have amended Claims 1 and 16, canceled Claims 7, 14 and 19. Currently in the application therefore are Claims 1-13, 15-18 and 20-23.

The Examiner objected to the drawings under 37 CFR § 1.83(a) for not showing the features called for in Claim 19. In response, Applicants have canceled such claim.

The Examiner has objected to the drawings for including reference numeral "120," which was not mentioned in the Specification. In response, Applicants have amended FIG. 2, to change the objected reference numeral to "20." Such numeral is used to designate the motor housing in paragraph 0006 of the Specification.

The Examiner objected to the Specification because it referred to European Patent Application No. EP 0 949 048 in paragraph 0005. The Examiner suggested that such reference be changed to —EP 0 305 849—. Applicants have not implemented the Examiner's suggestion as EP 0 305 849 is not an application currently owned by Black & Decker, the assignee of the present application.

The Examiner objected to the Specification because paragraph 00024 begins with question marks. As requested by the Examiner, such question marks have been removed.

The Examiner objected to typographical errors in Claims 1 and 16. In response, Applicants have amended such claims as suggested by the Examiner.

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The Examiner rejected Claims 1, 3-10, 12-16 and 19-22 under 35 USC § 102(b) as being anticipated by US Patent No. 4,245,533 ("Batson"). In addition, the Examiner rejected Claims 2-11 under 35 USC § 103(a) as being unpatentable over Batson in view of US Patent No. 6,289,778 ("Wixey"). Reconsideration and withdrawal of these rejections are respectfully requested.

Claim 1, as amended, calls for a miter saw comprising a base comprising a working surface, a saw assembly pivotally connected to the base, the saw assembly comprising a blade, the blade being movable in a first cutting plane, the cutting plane intersecting the working surface along a first cutting line, and an adjustable elongated fence mounted on and supported by the working surface, the fence being angularly displaceable relative to the first cutting line, and longitudinally adjustable along the cutting so that the fence is disposable in a first position defining a first plane supporting a workpiece and a second position defining a second plane supporting the workpiece, the first and second planes being substantially parallel.

Admittedly, Batson discloses a miter saw with a pivotable fence. However, fence 18 is "rotatably carried by the case base structure 12 for limited rotational movement about a vertical [sic] pivot located or adjacent the plane of the circular saw blade 20," i.e., the cutting line. Batson, col. 5, lines 29-34. Accordingly, fence 18 can only rotate, not linearly move back and forth.

By contradistinction, Claim 1 requires that "the fence [be] angularly displaceable relative to the first cutting line, and longitudinally adjustable along the cutting so that the fence is

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disposable in a first position defining a first plane supporting a workpiece and a second position defining a second plane supporting the workpiece, the first and second planes being substantially parallel." Because Batson does not disclose such arrangement, it cannot anticipate or render unpatentable Claim 1 and its dependent claims.

Wixey does not teach or suggest such missing element, as the Wixey fence rotates about an axis, and does not move longitudinally along the cutting line. Accordingly, the Batson/Wixey combination does not have all the elements of Claim 1, and thus cannot render unpatentable Claim 1 and its dependent claims.

Furthermore, Wixey should be disqualified as prior art pursuant to 35 USC § 103(c), as Wixey is owned by the owner of the present application. Applicants request that the Examiner identify the need for a Statement of Common Ownership, or whether the Examiner is withdrawing the rejection based on Wixey.

The Examiner also rejected Claims 1, 17-18 and 21-23 under 35 USC § 103(a) as being unpatentable over US Patent No. 5,960,691 ("Garuglieri") in view of US Patent No. 5,768,966 ("Duginske"). This rejection is respectfully traversed.

Garuglieri should be disqualified as prior art pursuant to 35 USC § 103(c), as Garuglieri is owned by the owner of the present application. A Statement of Common Ownership is being submitted concurrently as evidence to disqualify the Garuglieri reference as prior art. Accordingly, the rejection based on Garuglieri should be withdrawn.

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The Commissioner is authorized to charge payment of a one-month extension fee (\$120.00), as well as any other fees due in processing this amendment, or credit any overpayment to Deposit Account No. 02-2548.

In view of the foregoing, Claims 1-13, 15-18 and 20-23 are patentable and the application is believed to be in condition for formal allowance.

Respectfully submitted,



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